

REMARKS

By this amendment, limitations of claim 2 have been moved into claim 1, and claim 2 has been canceled. Claims 5 and 6 have been redrafted in independent form as claims 15 and 16, respectively, and claims 5 and 6 have been cancelled.

Claim 6 was rejected under 35 U.S.C. §103(a) over Taber. The Examiner argues that Taber “teaches” an invention which “relates to footwear generally and more directly to athletic shoes,” such that it would have obvious to provide the sole portion taught by Taber as part of a sandal or thong “to provide traction to the footwear.” Applicant disagrees for several reasons. First, there is no foundation for the argument that incorporation of *any type* of sole into a sandal or thong provides any traction, or additional tradition. Second, since Taber is directed to a non-slip tread for sparsely grassed natural turfs (i.e., a football or baseball shoe), implementation as a sandal or thong would not be obvious to one of skill in any art. Third, given that claim 6 is rejected on *obviousness grounds*, the limitation of each projection being selectively removable, thereby enabling a user to remove a subset corresponding to a personalized implant, would not be rendered obvious by Taber, since the purpose of Taber is to provide a non-slip tread. Removal of the projections would defeat this purpose, further defeating *prima facie* obviousness.

Claim 2 was rejected under 35 U.S.C. §103(a) over Ellis ('924). The Examiner concedes that Ellis is silent with respect to the sole-forming part of a sandal or thong, and the length and width of the projections. The Examiner again argues, however, that it would be obvious to incorporate the invention into a sandal or thong “to provide traction to the footwear.” The argument against this conclusion has already been made by Applicant above, with respect to Taber. But additionally, with regard to the length and width of the projections, the Examiner states that “the selection of a suitable size of the

protections, would *appear* to constitute no more than optimization ..." (emphasis added). However, this is not the standard to be used as the basis for obviousness. Moreover, the Examiner states that the Applicant has not demonstrated "or even alleged" that the claimed size produces unexpected results ... Again, this is not the standard for obviousness and, in fact, Applicant had alleged and demonstrated unexpected results, namely, the selective removal of the projections to produce a personalized footprint, an aspect about which the cited references are silent. The selective removal of the projections defeats an obviousness rejection here as well, since the stated purpose of Ellis, like Taber, is to reduce slippage and increase traction. Removal of the projections clearly runs counter to these goals.

Claim 5 was rejected under 35 U.S.C. §103(a) over Taber and/or Ellis, and further in view of Berger, provided by Applicant. It is well-settled that in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason *why* one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggested the combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

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In this case, the Examiner concedes that Berger teaches a sole portion that is partially transparent *to permit viewing of the toe tips.* The Examiner goes on to conclude that it would have been obvious to provide the sole of Berger (presumably to Taber or Ellis) "to permit viewing the toes within the shoe to determine whether the shoe is too small." First, there is no support whatsoever for this conclusion, and secondly, even if these references were to be combined for the Examiner's proffered purpose, it is

Serial No. 09/851,911

- 6 -

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clearly not the impetus underlying that of Applicant, namely, that a child or user could look through the shoe to remove the projections to form a personalized footprint.

Based upon the foregoing amendments and comments, Applicant believes all claims are in condition for allowance. Questions regarding this application may be directed to undersigned attorney at the telephone and facsimile numbers provided. Attached is a version showing the changes made to claims 1 and 3.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADEIN THE CLAIMS:

1. (Amended) Footwear for leaving a personalized imprint on wet sand and other surface, comprising:

a sole portion having a bottom surface with a densely packed [tight] matrix of projections extending therefrom, the density of the packing being such that the projections are immediately adjacent to one another if not touching, and wherein:

each projection has a nominal length of 3/16 inch or greater, and a nominal width of 1/8 inch or greater, and

each projection [being] is removable, enabling a user to remove a subset of the projections corresponding to the personalized imprint.

3. (Amended) The footwear of claim 1, wherein the projections are circular [, triangular, rectangular, square, or hexagonal] in cross-section.